



April 17, 2006

TO: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 3729 - Examiner Tugbang, Anthony D

FROM: George O. Saile, Reg. No. 19,572
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SUBJECT: Serial #: 10/781,168
File Date: 02/18/2004
Inventor: Danning Yang
Examiner: Tugbang, Anthony D
Art Unit: 3729
Title: Perpendicular Magnetic Pole Structure and Process

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated March 17, 2006. In that office action, restriction was required to one of the following Inventions under

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on April 17, 2006.

Signature 
Stephen B. Ackerman, Reg. No. 37,761

Date: April 17, 2006

35 U.S.C. 121:

The inventions stated are:

- I. Claims 1-4, drawn to a process of making a hard mask, classified in class 29, subclass 846.
- II. Claims 5-11, drawn to a process of making a pedestal, classified in class 216, subclass 38.
- III. Claims 12-22, drawn to a process of making a magnetic head, classified in class 29, subclass 603.07.
- IV. Claims 23-28, drawn to a product of a magnetic read head, classified in class 360, subclass 126.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group III, Claims 12-22, drawn to a process classified in Class 29, subclass 603.07. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I, II, III and IV as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the Invention III process Claims, for example, are directed to "a process to form a magnetic read head", and that the product claims are directed to "a magnetic read head ", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process classes/subclasses 29/846, 216/38 and 29/603.07 and product class/subclass 360/126, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "in the instant case, the product of Group IV can be made by a materially different process, such as one that forms the micro-device on a substrate by various casting and annealing techniques" is speculative and has nothing to do with the Claims as presented in this patent application.

The Examiner further states that Group III and Groups I, II are related as combination and subcombination, and gives as the reasons for distinctness that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. 806.05(c)). However, upon reading the Group I, II Claims

against the Claims of Group III, it can be seen that Groups I and II are drawn to "a method to form a hard mask" and "a method to trim, to a desired thickness, a narrow pedestal", while Group III is drawn to "a process to form a magnetic read head". As such, the field of search must necessarily cover both the Group I class/subclass 29/846, Group II class/subclass 216/38 and Group III class/subclass 29/603.07 in addition to other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group I, II and III inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "the subcombinations, each have separate utility, or a separately usable process, such as providing a substrate with a photoresist mold or surrounding a pedestal with an etch stop layer" is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of second and third patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,

A handwritten signature in black ink, consisting of a stylized 'S' followed by a large loop and a horizontal stroke.

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